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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/698,255	10/30/2000	Kenzou Sekiguchi	35.G2225 Div. I	3858
5514	7590	03/02/2004	EXAMINER	
FITZPATRICK CELLA HARPER & SCINTO			DINH, KHANH Q	
30 ROCKEFELLER PLAZA			ART UNIT	
NEW YORK, NY 10112			PAPER NUMBER	
			2151	20

DATE MAILED: 03/02/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/698,255

Applicant(s)

SEKIGUCHI, KENZOU

Examiner

Khanh Dinh

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 January 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 29-43 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 29-43 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

1. This is in response to the Request for Continued Examination filed on 1/8/2004 (paper #20). Claims 29-46 are presented for examination.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 29-46 are rejected under 35 U.S.C. 103(a) as being unpatentable over Himmel, US pat. No.6,167,441 in view of Adler et al, US pat. No.6,157,630. As to claims 29 and 46, Himmel discloses a communication device comprising:

communication means for transmitting an email transmission request to the email transmitted from the email server (server 165 fig.4) in response to the transmission request (HTTP request) and memory means (client's memory) for storing the email received from the email server (i.e., processing client's requests using the Internet, see figs.1, 2, abstract, col.3 line 22 to col.4 line 33 and col.4 line 42 to col.5 line 14).

acquisition means (i.e., using a client-smart agent 155 fig.2 to identify the type of client including screen size, amount of memory and other device parameters) for acquiring, before said communication means receives the email

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from the email server, size information of an e-mail from the e-mail server before sending the transmit request to the email server (col.5 line 15 to col.6 line 27).

determination means (using the client-smart agent to determine the type of client device) for determining based on the size of information (amount of memory) acquired by said acquisition means and an available of said memory means, the storage capacity of said memory means is sufficient to store data included in the email, wherein, if it is determined that the available storage capacity of said memory means is sufficient to store all the data included in the email, the email server transmits the email entirely (i.e., using the web server for transferring web pages depending the detected client type, see fig.3, col.6 line 28 to col.7 line 17).

a warning means (i.e., sending a dialog page to a user if the snooping was not successful), if said determination that the available storage capacity of said memory means is not sufficient to store all the data included in the email, for visually outputting warning information indicating that the email stored in the email server cannot be entirely received (see col.7 line 18 to col.8 line 51).

Himmel does not specifically disclose that the email server transmits only header data of the email. However, Zerber discloses the email server transmits only header data of the email (downloading emails' headers from server, see Zerber's abstract, figs.3, 5, col.7 line 1-52 and col.9 line 22 to col.10 line 48). It would have been obvious to one of the ordinary skill in the art at the time the invention was made to implement Zerber's teaching into the computer system of Himmel to process data information because it would have minimized data transfer time to

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only those messages and files to desired user in downloading data from the Internet (see Zerber's col.9 lines 22-58).

As to claim 30, Himmel discloses size information contains the size of data when an e-mail received from said e-mail server contains various kinds of data (i.e., images 257, 259 of fig.6, see col.8 lines 19-51).

As to claim 31, Himmel further discloses a recording means, wherein said output means generates a report indicating said warning information and records it using said recording means (i.e., presenting a dialog page in a language can be presented by the browser, see col.7 line 11 to col.8 line 51 and col.9 lines 7-53).

As to claim 32, Himmel discloses converting a received e-mail into image data and records that e-mail using said recording means (i.e., images 257, 259 of fig.6, see col.8 lines 19-51).

As to claim 33, Himmel discloses when a plurality of e-mails are stored in an e-mail server, a communication device executes reception of emails from said e-mail server in a predetermined order, until said determination means determines that it is impossible to receive an e-mail (see figs.3, 5, col.5 line 5 to col.6 line 44 and col.7 line 11 to col.8 line 51).

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Claims 34-38 are rejected for the same reasons set forth in claims 29-33 respectively.

Claims 39-43 are rejected for the same reasons set forth in claims 29-33 respectively.

As to claims 44 and 45, Zerber further discloses delete request means for requesting deletion of an email stored in the email server based upon a judgment (i.e., the client computer communicates a command to the mail server to delete the selected messages from the inbox in the mail server, see figs.4, 5, col.9 line 23 to col.10 line 49). It would have been obvious to one of the ordinary skill in the art at the time the invention was made to implement Zerber's deletion into the computer system of Himmel to delete marked messages because it would have minimized the data transfer time and enabled user to download only selected message bodies in the communications network (see col.10 lines 25-58).

Other prior art cited

4. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- a. Haneda et al, US pat. No.6,189,027.
- b. Lambert et al, US pat. No.6,038,601.

Response to Arguments

5. Applicant's arguments with respect to claims 29-46 have been considered but are moot in view of the new ground(s) of rejection.

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Conclusion

5. Claims 29-46 are *rejected*.
6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Khanh Dinh whose telephone number is (703) 308-8528. The examiner can normally be reached on Monday through Friday from 8:00 A.m. to 5:00 P.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Glenton Burgess, can be reached on (703) 305-4792. The Official fax phone number for this group is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305 -9600.

Khanh Dinh
Patent Examiner
Art Unit 2155
2/25/2004


FRANTZ B. JEAN
PRIMARY EXAMINER